

### **REMARKS/ARGUMENTS**

Applicants acknowledge receipt of the Office Action dated November 28, 2007. Claims 2-12 and 14-18 are pending. By this Response, Applicants have amended claims 3, 12, 14-15, and 18. No new matter has been added with these amendments.

In the Office Action, the Examiner: 1) rejected claims 2-4, 6, 8, 9, 12 and 14-18 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Deardurff et al. (U.S. Pat. No. 6,494,942, hereinafter “*Deardurff*”) in view of Okura et al. (U.S. Pat. No. 6,670,037, hereinafter “*Okura*”) and Russell (U.S. Pat. No. 5,137,833, hereinafter “*Russell*”); and 2) rejected claims 5, 7, 10 and 11 as being allegedly unpatentable over Deardurff, Okura and Russell in further in view of Kojima et al. (U.S. Pat. No. 5,380,612, hereinafter “*Kojima*”). Applicants believe all pending claims are allowable over the art of record and respectfully request reconsideration and allowance of all claims.

#### **I. CLAIMS 2-4, 6, 8, 9, 12, AND 14-18 ARE PATENTABLE OVER DEARDUFF IN VIEW OF OKURA AND RUSSELL**

Applicants respectfully traverse the Examiner's rejections of claims 2-4, 6, 8, 9, 12, and 14-18 under § 103 as being unpatentable over *Dearduff* in view of *Okura* and *Russell*. “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” See MPEP § 2143 (2007). To establish obviousness, each of the claim limitations must be taught or suggested by the prior art. See *CFMT, Inc. v. YieldUp Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). In addition, “[i]f an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03 (2007) (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Applicants respectfully submit that a case of obviousness has not been established in rejecting claims 2-4, 6, 8, 9, 12, and 14-18.

Claims 3, 12 and 18 are independent claims upon which claims 2, 4, 6, 8, 9, 12, and 14-17 depend, respectively. As amended claims 3 and 12 both teach

a “coating layer comprises one or more particles of a polyhydroxylated material having at least two hydroxyl groups positioned for binding with a boronic acid dye.” Claim 18, as amended, teaches “a boronic acid dye covalently bonded to one or more particles of a polyhydroxylated material on a coated print medium.” None of the cited references teach or suggest such limitations. In particular, Dearduff does not teach such limitations as the Office Action expressly admits *Dearduff* does not even teach or suggest a coating layer which comprises a polyhydroxylated material. Office Action, p. 3, Ins. 9-12.

*Dearduff* in combination with *Okura* also does not teach or suggest the limitations of claims 3, 12, and 18. *Okura* is primarily drawn to a coating agent containing an alumina dispersion. *Okura*, Abstract. Thus, *Okura* is directed to particles of alumina in a coating agent and does not teach or suggest one or more particles of a polyhydroxylated material having at least two hydroxyl groups positioned for binding with a boronic acid dye or a boronic acid dye covalently bonded to one or more particles of a polyhydroxylated material on a coated print medium. One of ordinary skill in the art would plainly know that alumina cannot be considered a polyhydroxylated material. Accordingly, *Okura* cannot supply *Dearduff* with the missing claim limitations.

*Dearduff* in combination with *Okura* and *Russell* also does not teach or suggest the claim limitations. *Russell* is directed to using boronic acid dyes to detect the presence of polyhydroxylated compounds such as glucose. *Russell*, col. 2, Ins. 36-38. More specifically, *Russell* teaches detection of polyhydroxylated compounds (i.e., glucose) dissolved in solution. See e.g., *Russell*, Example 1, col. 3, Ins. 56-60. Nothing in *Russell* teaches or suggests one or more particles of a polyhydroxylated material. As such, *Russell* also cannot supply *Okura* and *Dearduff* with the missing claim limitations.

Applicants therefore respectfully submit that the Examiner has not shown obviousness in rejecting claims 3 and 12, because the cited references do not teach or suggest all of the elements recited in the rejected claims. Since independent claims 3 and 12 are submitted to be allowable, dependent claims 2, 4, 6, 8, 9, 12, and 14-18 must *a fortiori* also be allowable, as they carry with them

all the limitations of claims 3 and 12. Accordingly, Applicants respectfully request that the Examiner withdraw the § 103 rejections and allow claims 2-4, 6, 8, 9, 12, and 14-18.

**II. CLAIMS 5, 7, 10 AND 11 ARE PATENTABLE OVER DEARDUFF IN VIEW OF KOJIMA AND RUSSELL.**

Amended claim 3 is an independent claim upon which claims 5, 7, 10 and 11 depend. As noted above, neither *Dearduff* or *Russell* teach or suggest the limitations of claim 3. Because claims 5, 7, 10 and 11 depend on claim 3, claims 5, 7, 10 and 11 are not obvious for the same reasons set forth in Section I for claim 3. Furthermore, nowhere does *Kojima* teach or suggest one or more particles of a polyhydroxylated material having at least two hydroxyl groups positioned for binding with a boronic acid dye as recited in claim 3. *Kojima* teaches use of various liquid hydroxylated compounds as solvents. *Kojima*, col. 8, Ins. 44-66. Thus, *Dearduff* even in combination with *Kojima* does not teach or suggest all the limitations of the claims. Accordingly, Applicants respectfully request withdrawal of this rejection and allowance of the claims.

**III. CONCLUSION**

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including

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fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

/Albert K. Shung/

Albert K. Shung  
PTO Reg. No. 60,682  
CONLEY ROSE, P.C.  
(713) 238-8000 (Phone)  
(713) 238-8008 (Fax)  
ATTORNEY FOR APPLICANTS

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
Legal Dept., M/S 35  
P.O. Box 272400  
Fort Collins, CO 80527-2400